



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

MAILED
DEC 02 2010
OFFICE OF PETITIONS

In re Application of :
Schelp, et al. : DECISION ON APPLICATION
Application No. 10/024,258 : FOR PATENT TERM ADJUSTMENT
Filed: December 21, 2001 :
Attorney Docket No. 05552.1450:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT-PRE GRANT" filed November 24, 2010, which is properly treated under 37 C.F.R. § 1.705(b). Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from forty-nine (49) days to two hundred and twelve (212) days.

The application for patent term adjustment is **DISMISSED**.

On September 29, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 49 days. On November 24, 2010, applicants timely submitted the instant application for patent term adjustment¹.

Applicants maintain the patent term should be adjusted by 163 days, pursuant to 37 CFR 1.702(a)(2). Specifically, applicants state that:

[a]n Office Action ... was mailed on July 14, 2004. In a phone conversation with Applicants' representative on August 12, 2004, the Examiner informed Applicant's representative that the restriction mailed July 14, 2004,

¹ The Office records show that the issue fee was received on November 24, 2010.

has been vacated, that no response is required, and that a new restriction would be issued...

Applicant believes an error in patent term adjustment occurred due to the PTO's use of the mailing date of the vacated Office Action (July 14, 2004) instead of the mailing date of February 2, 2005. Applicant respectfully submits that when the Office vacated the July 14, 2004, Office Action, it rendered that Office Action void and inoperative and without any force or effect. Accordingly, the mailing date of July 14, 2004, is irrelevant to Patent Term Adjustment.

An Office Action...was mailed on February 2, 2005, resulting in a PTO delay of 163 days beyond the 4 months provided by 35 U.S.C. 154(b) as measured by Applicant's response filed April 23, 2004.

Excerpt taken from APPLICATION FOR PATENT TERM ADJUSTMENT—PRE GRANT filed November 24, 2010, pgs. 2-3.

37 CFR 1.702 provides that:

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal taken;

37 CFR 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first[.]

OPINION

Applicants' argument has been considered but is not persuasive. In light of the application history, it has been determined that no additional period of adjustment for Office delay pursuant to 37 CFR 1.702(a)(2) is warranted. It is undisputed that the Office mailed an action under 35 U.S.C. 132 in the form of a restriction requirement on July 14, 2004, within four months of the reply under 37 CFR 1.111 filed April 23, 2004. The subsequent mailing of another Office action under 35 U.S.C. 132 does not alter the date used in calculation of the period of adjustment. Pursuant to 35 U.S.C. 154(b)(1)(A)(ii), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by the Office, after four months from the filing of the reply under 37 CFR 1.111 or appeal taken. The fact that the Office later withdrew the Office action does not negate the fact that the Office took action within the meaning of 37 CFR 1.702(a)(2) on July 14, 2004. Further, the examiner does not have the authority to vacate, rescind, or withdraw an Office action. Unless vacated by the Technology Center Director, for purposes of calculating patent term adjustment, the action originally mailed by the examiner on July 14, 2004, will be used to calculate the amount of Office delay, if any, due to the examination delay pursuant to 37 CFR 1.702(a)(2) and 37 CFR 1.703(a)(2). See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000). Accordingly, no additional period of adjustment to the patent term pursuant to 37 CFR 1.702(a)(2) will be entered.

In view thereof, the patent term adjustment at the time of the mailing of the Notice of Allowance remains 49 days.

The \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent.

The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all

outstanding requirements, and for the Office taking in excess of three years to issue the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions